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EXAMINER				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/049,144

**Applicant(s)**

MUEHLBACH, JOBST MATTHIAS

**Examiner**

JASON K. LIN

**Art Unit**

2425

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 September 2008.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 8, 14-17, 19-30, 32 and 33 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1, 8, 14-17, 19-30, 32 and 33 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 05 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This office action is responsive to application No. 10/049,144 filed on 09/18/2008.

**Claims 1, 8, 14-17, 19-30, and 32-33** are pending and have been examined.

#### *Response to Arguments*

2. Applicant's arguments filed 09/18/2008 have been fully considered but they are not persuasive.

A) In response to applicant's argument on P.8: lines 1-19 regarding "a built-in banner", that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "...a built-in application, called Banner stored in the decoder in order to allow a user to navigate or surf through all available services. This built-in software presents all services to the viewer and enables the channel changing process. In other words, the Banner handles all channel-changing processes inside the decoder." ) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

With that in mind, although present in the specifications, these limitations are not explicitly recited in the claims and therefore are not read into the claims. The examiner maintains the same rejection on the ground(s) previously cited, and reiterates the point(s) made in the previous action.

B) Response from office action dated 06/18/2008 - "The applicant is not explicitly claiming a built-in banner, but something that is **"termed"** a built-in banner

corresponding to a built-in application. The way it is claimed merely, states a second application that is **called** or **named** a built-in banner that corresponds to a built-in application, and does not explicitly further limit and explicitly define what constitutes a built-in banner. Therefore, a component that corresponds to a built-in application such as the part of software in Kostreski that handles presentation of services meets the claimed limitations. As stated in the cited portions of Kostreski in the current office action, Col 27: lines 26-34, when no surfer application is readily available, the event is transferred to the DET to handle the requested navigation event. Therefore, the built-in application of Kostreski does in fact get routed the navigation event when there is no surfer application available and handles the event accordingly."

C) In P.8: line 20 – P.9: line applicant's assert "However, there is no disclosure of routing to a built in application that handles all channel changing and presentation of services for all available services (i.e., to a built-in banner). Furthermore, Kostreski suggest that when it is determined that no surfer application is available, rather than using a built-in banner, a new Surfer application is sought... Therefore, not only does Kostreski not disclose a built-in banner as claimed, Kostreski neither teaches nor suggests 'routing said navigation event to the built-in banner, in response to determining no surfer application is available and the decoder is not under control of a surfer application..."

In response the examiner respectfully disagrees. Please take note of Part (A) in examiner's response where limitations from the specification are not read into the claims. The built-in banner as claimed is a built-in application for presenting services,

and has a navigation event routed to it, and does not contain any extra claimed limitations as cited by the applicant above. Also, please see response in Part (B) regarding routing of said navigation event to the built-in banner. Note that the limitation only claims "routing said navigation event to the built-in banner, in response to determining no surfer application is available and the decoder is not under control of a surfer application" and does not require anything further. The routing of such a navigation event is taught by Kostreski as cited in part (B) of examiner's response above.

D) In regards to claims 32 and 33, please see examiner's rejection below.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1, 8, 14, 16, 17, 21, 22, 25, and 26** are rejected under 35 U.S.C. 103(a) as being unpatentable over Kostreski et al. (US 5,734,589), in view of Gordon et al. (US 6,208,335).

Consider **claims 1 and 8**, Kostreski teaches an interactive broadcasting system and corresponding method for controlling navigation events between a plurality of services and/or channels (Col 3: lines 62-65), including at least one

interactive decoder (100-Fig.1), said decoder receiving broadcast applications (Col 6: lines 36-41), applications utilized by the decoder being categorised into at least two types of applications including a first type termed a surfer application for controlling said navigation and having knowledge of said services (Col 13: lines 52-62; Col 15: lines 15-32), and a second type termed a built-in banner corresponding to a built-in application for presenting services (Col 15: line 58 - Col 16: line 5; Col 27: lines 26-30), wherein the decoder is configured to:

identify in a broadcast stream a surfer application (Col 28: lines 12-15);

download the surfer application (Col 13: lines 48-51);

detect a navigation event (Col 27: lines 22-30—pressing of the "GUIDE" button);

check whether a first surfer application is available or said decoder is under control of a first surfer application (Col 27: lines 22-30);

route said navigation event to the first surfer application, in response to determining the surfer application is available or the decoder is under control of the first surfer application (Col 15: lines 28-32; Col 27: lines 22-26); and

route said navigation event to the built-in banner, in response to determining no surfer application is available and the decoder is not under control of a surfer application (Col 27: lines 26-34).

Kostreski does not explicitly teach wherein the first surfer application is started in a transparent mode by default.

In an analogous art Gordon teaches, wherein the first surfer application is started in a transparent mode by default (Col 3: lines 20-30 teaches the graphics of the OSD layer {first surfer application} can be transparent; Col 7: lines 20-25, 31-40, 46-50, Col 8: lines 1-3 teaches that provided control instructions for a menu is contained in an applet that defines a transparent OSD. *The applet downloaded has already predefined how the OSD should be displayed, therefore the OSD is in transparent mode by default.*

Therefore, it would have been obvious to a person of ordinary skill in the art to modify Kostreki's system to include wherein the first surfer application is started in a transparent mode by default, as taught by Gordon, for the advantage of allowing the underlying video that lies beneath the overlay to be seen (Gordon - Col 3: lines 29-31).

Consider **claims 14 and 22**, Kostreski and Gordon teach wherein in response to detecting said navigation event and determining the decoder is under the control of the first surfer application, the method further comprises:

the first surfer application entering a visible mode of operation; and selecting a service corresponding to said navigation event (Kostreski - Col 27: lines 32-33).

Consider **claims 16, 17, 25 and 26**, Kostreski and Gordon teach the system and corresponding method wherein the decoder is further configured to

present an interface including a list of surfers that allows the user to select one particular surfer application from said list and to come back to said list after selection, if desired (Kostreski - Fig. 5; Col 5: lines 58-66; Col 28: lines 40-52; Col 28: line 66 - Col 29: line 3).

Consider **claim 21**, Kostreski and Gordon teach the surfer application has a visible mode of running, but does not explicitly teach the surfer application has a transparent mode of running.

In analogous art, Gordon teaches the surfer application has a transparent mode of running (Col 3: lines 20-30, Col 7: lines 31-35 teaches the graphics of the OSD layer {surfer application} can be transparent).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kostreski by including in the surfer application a transparent mode of running, as taught by Gordon, in order to allow the underlying video that lies beneath the overlay to be seen (Gordon - Col 3: lines 29-31).

5. **Claims 15, 23, 24 and 27** are rejected under 35 U.S.C. 103(a) as being unpatentable over Kostreski et al. (US 5,734,589), in view of Gordon et al. (US 6,208,335), and further in view of Ichihashi et al. (US 5,903,262).

Consider **claims 15, 23 and 24**, Kostreski does not explicitly teach the surfer application is stopped when an application different from the surfer



application is displayed, and is re-launched when the normal application is finished.

In analogous art, Ichihashi teaches an information guide menu screen that provides different information exchange services for presentation to the user. When the user wishes to terminate the information exchange service, a menu button is pushed, therefor causing the selection menu screen for information exchange having plural selectors to appear again (Col 26: line 45 - Col 27: line 5; Col 31: lines 9-60).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kostreski by stopping the surfer application when another application is displayed, and re-launching the surfer application upon termination of the normal application, as taught by Ichihashi, in order to give the user the ability to activate and terminate different services through simple manipulation of a controller (Ichihashi - Col 27: lines 23-27).

Consider **Claim 27**, Kostreski teaches the system according to claim 23 wherein the decoder is further configured to present an interface including a list of surfers that allows the user to select one particular surfer application from said list and to come back to said list after selection, if desired (Kostreski - Fig. 5; Col 5: lines 58-66; Col 28: lines 40-52; Col 28: line 66 - Col 29: line 3).

6. **Claims 19 and 30** are rejected under 35 U.S.C. 103(a) as being unpatentable over Kostreski et al. (US 5,734,589), in view of Gordon et al. (US 6,208,335), and further in view of Arai et al. (US 2004/0221307).

Consider **claims 19 and 30**, Kostreski teaches a service browser method and surfer application, but does not explicitly teach a DVB environment and Bouquet Association Tables (BAT).

In analogous art, Arai et al. teaches a Digital Video Broadcasting (DVB) environment wherein contents common to the pieces of electronic program information of all broadcast service providers is prepared in a common electronic program information preparing unit, for example, a bouquet association table (BAT). In the BAT, names of channel services of all broadcast service providers, names of all transport streams including the channel services, and names of bouquets are described in a list. Each bouquet corresponds to one broadcast service provider (Paragraph 0219).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kostreski by including the service browser process to be in a DVB environment, and the surfer application to be signaled in a Bouquet Association Table, as taught by Arai, in order to provide a common interface to all broadcast service providers, thereby benefiting from the existing tables (Arai - Paragraph 0219).

7. **Claims 20, 28, and 29** are rejected under 35 U.S.C. 103(a) as being unpatentable over Kostreski et al., in view of Gordon et al. (US 6,208,335), and further in view of Strauss et al. (US 5,790,173).

Consider **claims 20, 28 and 29**, Kostreski and Gordon do not explicitly teach wherein a memory of the decoder comprises a plurality of surfer caches for storing corresponding different surfer applications, and selecting one of said downloaded surfer applications.

In an analogous art Strauss teaches, a memory of the decoder comprises a plurality of surfer caches for storing corresponding different surfer applications, and selecting one of said downloaded surfer applications (Col 18: lines 45-51 teaches different applications programs that may be downloaded to the DET for the user to interact with service providers. Col 23: lines 14-17, Col 25: lines 47-55, Col 27: lines 55-60 teaches the different types of applications programs)

Therefore, it would have been obvious to a person of ordinary skill in the art to modify the system of Kostreski and Gordon to include wherein a memory of the decoder comprises a plurality of surfer caches for storing corresponding different surfer applications, and selecting one of said downloaded surfer applications, as taught by Strauss, for the advantage of efficiently storing and providing users with different applications that enable them to easily interact with services and navigate to selected desired selections for consumption.

8. **Claims 32 and 33** are rejected under 35 U.S.C. 103(a) as being unpatentable over Kostreski et al. (US 5,734,589), in view of Gordon et al. (US 6,208,335), and further in view of Terakado et al. (US 6,311,329).

Consider **claims 32 and 33**, Kostreski and Gordon do not explicitly teach the built-in banner is configured to present services without use of a downloaded surfer application.

In an analogous art Terakado teaches, present services without use of a downloaded surfer application (Figs.1, 3; Col 5: lines 27-46, Col 6: lines 5-15, Col 7: lines 36-57 teaches an electronic program guide stored on a CD-ROM that is read by the client and outputs an Electronic Program Guide for presenting available programs).

Therefore, it would have been obvious to a person of ordinary skill in the art to modify the system of Kostreski and Gordon to include present services without use of a downloaded surfer application, as taught by Terakado, for the advantage of raising the speed upon displaying (Terakado - Col 7: lines 44-46), and allowing the client to easily and quickly display corresponding services.

### ***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JASON K. LIN whose telephone number is (571)270-1446. The examiner can normally be reached on Mon-Fri, 9:00AM-6:00PM, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian T. Pendleton can be reached on (571)272-7527. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Jason Lin/  
Examiner, Art Unit: 2425

/Hunter B. Lonsberry/  
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